



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,813	11/13/2001	Alistair William McLean	1263.2129	6204

5514 7590 06/02/2005

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

HANNE, SARA M

ART UNIT	PAPER NUMBER
----------	--------------

2179

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/986,813

Applicant(s)

MCLEAN, ALISTAIR WILLIAM

Examiner

Sara M Hanne

Art Unit

2179

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-6,8-10,12-28,30,52-54 and 58-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-10,12-28,30,52-54 and 58-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/19/04, 11/19/02, 12/24/02, 5/2/02</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. This action is responsive to the amendment received on February 17, 2005.
Claims 1-6, 8-10, 12-28, 30, 52-54 and 58-72 are pending in the application.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-6, 8-10, 12-18, 23-28, 30, 52-54, 58 and 60-66, 68-72 are rejected under 35 U.S.C. 102(e) as being anticipated by Foster, US Patent 6211870.

As in Claims 1-2, 23, 27-28, and 61-66, Foster teaches a user-interface apparatus comprising a housing containing a user interface provider (Fig. 1 with

corresponding text), method and system for enabling a user to communicate with any processor-controlled machines ("various multimedia processing units") connected in a network as described below:

a data requester establishing communication with the network and operable to request a device description defining all of the functions that the processor-controlled machine is capable of carrying out ("Lookup" and "Learn" Fig. 3, with corresponding text), a receiver operable to receive, in response to the request from the data requester, device description provided by the processor-controlled machine (Col. 8, line 40 et seq. and Figures 6-7 and corresponding text), a user interface element accessor operable to access user interface element data defining user interface elements that can be used to form a user interface (Figure 10, refs. 1052 and 1065), an associator operable to associate the functions defined by the received device description data with user interface elements defined by the user interface element data (Figure 10, refs. 1060 and 1065 and corresponding text), a generator operable to generate user interface data defining a user interface using the user interface element data for the user interface elements associated by the associator with the functions capabilities defined by the device description (Development Phase, Col. 10 line 28 et seq.), and a wireless (Use Phase, Col. 12) communicator operable to communicate with the processor-controlled machine to cause the processor-controlled machine to carry out a function selected by the user using the user interface generated by the generator (Column 4, lines 48-50 and Use Phase, Col. 12, line 1 et seq.), a preference provider providing pre-stored preference data regarding user interface element preferences (Fig. 3-4 Type and Name

selected by the user), a user interface element determiner operable to determine, using the user interface element option data and the pre-stored preference data, the user interface elements to be used to represent the functions of the processor-controlled machine (Column 11, lines 8-13), wherein a function is associated with two possible alternative user interface elements (soft key or programmable keys, Column 10, lines 62-63),

As in Claim 3, Foster teaches the preference provider is operable to provide preference data defining preferences of at least one of the user of the user interface apparatus and the supplier of the user interface apparatus (the user controls the development phase, Column 10, line 28 et seq.).

As in Claim 4, Foster teaches the preference provider is operable to provide preference data defining at least one of preferences for different types of user interface elements, preferences for the style of presentation of user interface elements and preferences for layout of user interface elements ("modify the shape and location of soft keys, ... change text labels, and otherwise edit the appearance of the screen object", Column 10, lines 61-64).

As in Claim 5, Foster teaches preference data defining preferences for different types of user interface elements such as button user interface elements and user interface element style preferences to be used for user interface elements (Column 10, lines 50-64 and Figure 10, Ref. 1050, 1052).

As in Claim 71, Foster teaches the preference provider is operable to provide preference data defining preferences for at least one of button, menu or combo box type

user interface elements and at least one of color, font and font size user interface element styles to be used for user interface elements (Col. 10, line 50 et seq.).

As in Claim 6, Foster teaches the apparatus having a display for displaying the graphical user interface to a user (Figure 8).

As in Claim 8, Foster teaches the data requester operable to communicate with a number of different processor-controlled machines to request from each processor controlled machine a device description for the requested processor-controlled machines defining the functions that the requested processor-controlled machine is capable of carrying out (Col. 9, line 12 et seq.) and the receiver operable receive device description data provided by any of different processor-controlled machines in response to such request (as in Figure 9, the TV and Cable data have been received).

As in Claim 9, Foster teaches the data requester operable to communicate directly with a processor-controlled machine (Column 8, lines 40 et seq.).

As in Claim 10, 24, Foster teaches the data requester is operable to communicate with a processor-controlled machine via a network to which the processor-controlled machine is coupled (Figure 1).

As in Claims 12, and 26, Foster teaches the receiver operable to receive the device description directly from a processor-controlled machine (Figures 5-6 and corresponding text) or a network of processor-controlled machines (TV and Cable).

As in Claims 13, 25, and 30, Foster teaches the receiver operable to access the device description using a look-up service provided by a network to which the processor-controlled machine is coupled (Column 8, lines 26-39).

As in Claim 14, Foster teaches the user interface provicer is provided by a processor and associated memory storing a user interface implementable by the processor (Column 4, lines 54-67).

As in Claim 15, Foster teaches the user interface application comprising several separate program modules (Figure 10).

As in Claims 16-17, Foster teaches the data requester communicator, receiver, user interface element accessor, associator, and generator comprise respective different program modules (each have their own code associated with controlling that aspect).

As in Claim 18, Foster teaches a processor controlled machine for use with a user interface apparatus the process controlled machine having a functioner for carrying out a function ("a message which can be recognized by a multimedia processing unit as an instruction to change a particular setting of the multimedia processing unit.", Column 4, lines 48-50), a wireless (Use Phase, Col. 12) machine communicator for communicating with the user interface device to enable the user of the user interface to cause the processor-controlled machine to carry out a function, and a device description data provider for providing to the user interface apparatus upon request by the data requester a single device description data defining the functional capabilities of the processor-controlled machine is capable of carrying out (See Claim 1 rejection *supra*).

As in Claim 52, user settable data handling parameter defining means having a parameter (ie. volume or channel) settable by a user (depressing the corresponding button) and data handling means for handling received data in accordance with at least

one data handling parameter set by the user (function carried out by the multimedia processing unit under controls set by the remote).

As in Claim 53, the data handling means is operable to divert an incoming message so that the user is not made aware of the message (mute).

As in Claim 54, the data handling means is operable to send received data to a location determined by a parameter set by the user (corresponding multimedia processing unit currently being controlled by the interface).

As in Claim 58, a user interface modifying means for modifying the user interface in response to data identifying the availability of another processor-controlled machine (ie. the TV interface has been created and the Cable interface is begun as seen in the transition from Figure 7 to Figure 9).

As in Claim 68, Foster teaches the network manager is operable to determine whether a particular type of processor-controlled machine is coupled to the network by registering with a manager of the network a request to be advised when a processor-controlled machine of that type is coupled to the network (Fig. 3-6 with corresponding text).

As in Claim 69 and 72, Foster teaches a user interface controller operable to control the user interface for said processor-controlled machine in accordance with whether or not the other processor-controlled machine is coupled to the network so as to indicate to the user that the further function is not available when the other processor-controlled machine is not coupled to the network and to indicate to the user that said

further function is available when said other processor-controlled machine is coupled to the network (VCR requires TV) along with the limitations of Claim 1 rejected *supra*.

As in Claim 70, Foster teaches the user interface controller is operable to control the user interface for said processor- controlled machine to cause a user interface display representing said further function to be shown as inactive when said other processor-controlled machine is not coupled to the network (cannot activate functions when multimedia unit is off).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 19-22, 59 and 67 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Foster, US Patent 6211870. It appears that the "printer", "facsimile", "copying function" and "scanning function"s are inherently included in Foster teaching of "controllable multimedia processing units" because printers, fax machines, copiers and scanners are media transmission devices. Even if it is not, the limitation of controlling a "printer", "facsimile", "copying function" and "scanning function" is well known. One of ordinary skill in the art

would have been motivated to make such a combination because document processing controller interface would have been obtained.

Response to Arguments

Applicant's arguments filed 2/17/05 have been fully considered but they are not persuasive. In response to the argument that Foster fails to teach the features of Claims 1 and 23, the examiner disagrees. Foster teaches requesting device description of the functions to be carried out by various multimedia processing units (tvs VCRs etc.) and receiving the data in order to create the interface for the remote. Foster not only teaches requesting device description for all of the functions (despite the "Learn" system is done one key at a time) but also a lookup system. Furthermore, the invention of Foster teaches the general purpose computer connected with the remote through the docking station as one entity (Col. 4, lines 64 et seq.). Also in response to the argument that Foster fails to teach pre-stored preference data regarding user interface element preferences, the examiner disagrees. Before assigning keys and retrieving device description the user pre-stores what type of remote will be programmed and it's name in Figure 3 which will determine Fig. 7, ref. 766, 711 and, as an example, the prefix labeled "TV-1" in Fig. 7

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action. The documents cited therein teach similar processor-controlled devices networked to controllable and customizable interfaces.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara M Hanne whose telephone number is (703) 305-0703. The examiner can normally be reached on M-F 7:30am-4:00pm, off on alternating Fridays.

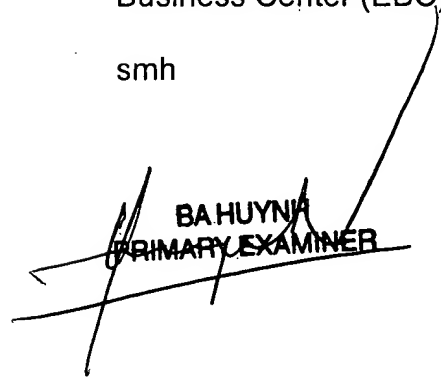
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (703) 308-5186. The fax phone

Art Unit: 2179

number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

smh


BA HUYNH
PRIMARY EXAMINER